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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,429	01/16/2004	Merrill Brooks Smith	64243.000006	5641

27682 .7590 12/13/2006

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EXAMINER
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ST CYR, DANIEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/758,429

Applicant(s)

SMITH ET AL.

Examiner

Daniel St.Cyr

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-60, 62, 63 and 65-71 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-60, 62, 63 and 65-71 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is in response to the applicant amendment filed 9/11/06 in which claims 1, 3, 8, 45, 48, 49, 53, 56, 62, 65, 67-71 were amended and claims 5 and 64 were canceled.

#### ***Claim Objections***

2. Claims 1, 3, 8, 45, 48, 53, 56, 62, 65, 67-71 are objected to because of the following informalities: The claims were amended to include specific language, such as "inserting the value into the customer's account", such language should be change to more appropriate language such as redeeming/refunding the account, crediting the account, etc. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6-60, 62, 63, and 65-71 are rejected under 35 U.S.C. 102(e) as being anticipated by Risafi et al, US Patent No. 6,473,500.

Risafi et al disclose a system and method for using a prepaid card comprising: step of closing a card account (when the account has remaining funds therein, closing it is to request a return/refund), closing the account requires withdrawing all the value remaining in the account and then disabling the account and the card's access to that account, the closing of an account can be performed at an ATM, through an agent terminal, through some other approved device,

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or through the issuer 102. For instance, the card user 10 presents card 100 to agent 104 and requests a closure of the account along with the refund of the rest of the funds in the account; the card user 10 inputs the PIN to agent terminal 402, and the agent terminal 402 transmits the card number, PIN, and transaction code to prepaid debit card center (PDC ) 404, the PDC 404 checks the Card File to verify that the PIN matches and that all other issuer- or PDC-specified criteria have been met and determines how much value remains in the account, the PDC 404 sets the card account balance to zero and decrements the Account File by the amount of the refund, and transmits an approval and the amount of the refund to agent terminal 402; once approval is received, the agent 104 gives the money to card user 10, minus any transaction fees. The structure of Risafi et al is capable of performing all the method steps as set forth in the claims. (See figs. 8a-b; col. 15, line 13+).

### ***Response to Arguments***

5. Applicant's arguments filed 9/11/06 have been fully considered but they are not persuasive. (See examiner remarks).

### **REMARKS:**

In response to the applicant's first argument on page 12, paragraph c (claim 1), the examiner respectfully disagrees. Risafi discloses determining how much value remains in each card account, setting the account to zero, decrementing the determined value from the account, and transmitting the value to the sponsor's account. Since after each account is set to zero after determining the remaining value therein, if an account is determined to have remaining value, it also determined that such account has not been refunded. ( See fig. 8B).

In response to claims 2-4 and 6-44, the only argument is that they depend on claim 1.

In response to the applicant's argument regarding claims 45, 56, and 68-71, on page 14, 17, and 18 respectively, the examiner respectfully disagrees. Risafi discloses determining how much value remains in each card account, setting the account to zero, decrementing the determined value from the account, and transmitting the value to the sponsor's account. Since after each account is set to zero after determining the remaining value therein, if an account is determined to have remaining value, it also determined that such account has not been refunded. ( See fig. 8B; col. 15, line 50+).

In response to claims 46-55, 57-60, 62, 63, and 65-67, the only argument is that they depend on claim 45.

In general closing out a prepaid/debit card account by where the user is refunded the unused fund is to return a product, the product being the card itself. The applicant's arguments are not persuasive. Refer to the rejection above.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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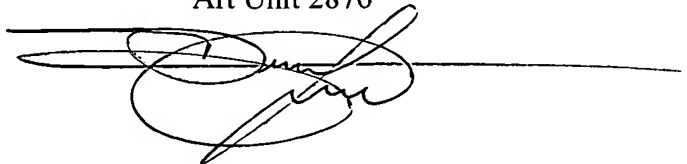
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Daniel St.Cyr  
Primary Examiner  
Art Unit 2876

A handwritten signature in black ink, appearing to read 'Daniel St.Cyr', is written over a horizontal line. The signature is stylized with loops and a long horizontal stroke extending to the right.

DS  
November 21, 2006